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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,510	09/28/2001	Tomoyuki Ishii	1307.65742	7411

7590

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EXAMINER

AWAD, AMR A

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 05/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,510

Applicant(s)

ISHII ET AL.

Examiner

Amr Awad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/19/2004 has been entered.

Claim Rejections - 35 U.S.C. ' 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 21-22 and 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 recites Awherein said at least one first discharge sustaining pulse and said at least one second discharge sustaining pulse are applied such that a current in said first pair of display electrodes flows in the opposite direction from a current in said second pair of display electrodes@. Such limitation was never mentioned in the specification or in the original claimed of the parent application, which raises new matter situation. A clarification is respectfully requested.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,373,452 (Pat_452). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 23 and 25 of the present application are substantially similar to claims 1-2 of Pat_452. By comparing independent claim 23 of the present application and claim 1 of Pat_452, we can see that the citation "A method of driving a plasma display panel having a plurality of pairs of display electrodes" of the present application is similar to the citation "A method of driving a plasma display panel having a plurality of X-electrodes, Y-electrodes..." of the Pat_452. The citation "applying a set of first discharge sustaining pulses to each electrode..." of the present application is similar to the citation "displaying by discharging between one of said Y-electrodes and one of said X-electrodes adjacent thereto..." The citation "simultaneously applying a set of second discharge sustaining pulses..." of the present

application is similar to the citation "displaying by discharging between one of said Y-electrode..." of Pat_452. The citation "wherein said first set of discharge sustaining pulses applied.... are in the same phase as each other" is not cited in claim 1 of Pat_452. However, claim 1 cites "wherein steps 1 and 2 are separated in time to each other, which means that the discharge between the first pair (adjacent X and Y) would be similar to a second pair (another adjacent X and Y), which makes the phase similar to adjacent electrode in the two adjacent pairs.

Response to Arguments

6. Applicant's arguments filed October 31, 2003 have been fully considered but they are not persuasive.

Applicant (page 4) argued that the claimed feature "such that a current in said first pair of display electrodes flows in the opposite direction from a current in said second pair of display electrodes" is supported, for example, by the present specification, page 38, lines 15-20, page 39, lines 2-5, page 40, lines 6-8, lines 14-15 and FIGS 4 and 7. Examiner respectfully disagrees. The examiner submits that the entire specification does not include any mentions of the word current. The long explanation provided by the Applicant would not be understood to one skilled in the art from the description of the specification. In fact, the Applicant needed a reference figure to present the limitations. The current I1, I2 and I0 were never introduced in the specification. Examiner may agree with the applicant that actual invention may in reality has the current in the first pair of display electrodes flows in the opposite direction from

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a current in the second pair of electrodes. However, such assertion had to be included in the original specification to enable a person of ordinary skill in the art to fairly reach that such limitation is part of the invention. Examiner does not believe that such description was not found in the original specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (703)308-8485. The examiner can normally be reached on Monday-Friday, between 9:00AM to 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



5-1-2004

A.A.